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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/678,295	10/02/2000	Mathias Entenmann	12964.15	4137

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HAYNES AND BOONE, LLP  
901 MAIN STREET, SUITE 3100  
DALLAS, TX 75202

EXAMINER

FELTEN, DANIEL S

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 07/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/678,295

Applicant(s)

Entemann

Examiner

D. Feiten

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 4/11/2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7, 9-19, 21-23 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-4, 7, 18 and 19 is/are rejected.
- 7) ☒ Claim(s) 5, 9-17, 21-33 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

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4 1. Receipt is acknowledged of the amendment filed April 11, 2002 adding claims 23-33,  
5 canceling claims 6, 8 and 20 and amending claims 1, 5, 9-17, 21 and 22. Claims 1-5, 7 and 9-  
6 19 and 21-33 are pending in the application and are presented to be examined upon their  
7 merits.

### *Response to Arguments*

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9  
10 2. Applicant's arguments filed have been fully considered but they are not persuasive.  
11 The rejection of claims 1-4, 7, 18 and 19 are maintained.

12 Applicant has argued that the applied references are defective in establishing a prima  
13 facie case of obviousness and that the combination of Hultgren in view of Musa can not be  
14 applied to the rejected claims under 35 U.S.C. § 103(a) because the combination of the cited  
15 prior art does not render obvious the subject matter of claim 1 and claim 3 as a whole.

16 Firstly, it is respectfully submitted to applicant that in order to establish a prima facie  
17 case, the following three criteria must be met:

1           (1)     *Some suggestion or motivation by the reference or general knowledge of one of*  
2     *ordinary skill in the art:*

3           In this case the primary reference, Hultgren discloses a wireless cashless transaction  
4     method/system in that (among other wireless devices) uses a mobile phone in combination with  
5     a subscriber identification mobile ("SIM") card (see Hultgren, page 26), but fails to disclose that  
6     the card is a "Smart" card with an ID code identifying it. The secondary reference, Musa  
7     discloses the fact that the combination of a cell phone used in combination with a smart card is  
8     known within the art (see Musa, col. 2, ll. 45-59). The motivation given for the combination of  
9     references by the examiner in the previous office action mailed October 2, 2002 was, "...an  
10    artisan of ordinary skill at the time of the invention would have considered the modification *a*  
11    *substitution of art equivalence* inasmuch as both cellular phones in this aspect of the invention  
12    are relating to identification of the user."

13  
14           (2)     *There must be a reasonable expectation of success:*

15           It is respectfully suggested the applicant read the prior office action again where it states,  
16     "...an artisan or ordinary skill in the art would recognize the notoriously old and well known  
17     combination of a smart card and cell phone as *a cost effective* means of user identification."  
18     Furthermore, one of ordinary skill in the art would have sought out the smart card for providing  
19     the latest identification security technology for remote activation/deactivation devices (see  
20     Musa col. 1, ll. 36+).

1  
2  
3 (3) *The prior art references must teach **or suggest** all the claimed limitations:*

4 It is respectfully submitted that the applicant carefully read over the primary and secondary  
5 references again in light of the previous office action of October 2, 2002 and in light of the  
6 claims presented to the examiner at the time prior office action was mailed. The examiner  
7 maintains that the combination of references do teach or suggest to one of ordinary skill in the art  
8 all the limitations of at least claims 1 and 3. The examiner also has provided reasoning for the  
9 combination of references for one of ordinary skill in the art within the previous office action.

10 Since the examiner is under compliance with the criteria set forth above, it is maintained  
11 that the prima facie case is proper.  
12

13 Secondly, it is respectfully submitted to the applicant that references are evaluated by  
14 what they suggest as a whole to one versed in the art, rather than their specific disclosure [see In  
15 re Bozek, 163 USPQ 545 (CCPA 1969)].

16 Thirdly, The present limitations of the claims 1 and 3 at present do not claim 1a,b,c or  
17 3a,b,c, d as stated in applicant's remarks on page 9. There is no recitation, as stated in 1a,b and  
18 3a,b, in the combination of claims of a "start" of the method beginning with the merchant. In  
19 fact the initial transaction/payment method of claims 1 and 3 read as being started by either the

1 customer or (perhaps) the comparing device (which is not the merchant). For example, the  
2 claim(s) cites,

3 “...reading an amount of money to be paid into the merchant station...” or the comparing  
4 device finding how much is owed by the customer or the customer finding out how much is owed  
5 to the merchant.

6 “....transmitting the identification code of the merchant station and at least the amount of  
7 money to the comparing device with this identification code through a data link...” or the  
8 customer transmitting the merchant station ID code and the money to the comparing device via a  
9 data link. Hultgren covers these concepts on at least pages 8 and 9.

10 The concept of 1c and 3c of a “confirmation call”, although not recited explicitly in  
11 claims 1 and 3, is found in Hultgren (page 9+ or page 11+).

12 The concept of 3d of “...an independent route...” is not explicitly claimed and is  
13 ambiguous because it is not clear what the applicant is referring to within the limitations of  
14 aforementioned claim(s).

15 At least for the aforementioned reasons presented above, the rejection of claims 1-4, 7,  
16 18 and 19 are maintained.

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*Allowable Subject Matter*

3. Claims 5, 9-17 and 21-33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Conclusion*

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Daniel S. Felten** whose telephone number is (703) 305-0724. The examiner can normally be reached between the hours of 7:00AM to 5:30PM Monday-Thursday. Any inquiry of a general nature relating to the status of this application or its proceedings should be directed to the Customer Service Office (703) 306-5631, or the examiner's supervisor **Vincent Millin** whose telephone number is (703) 308-1065.

5. Response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

for formal communications intended for entry, or (703) 305-0040, for informal or draft communications, please label "Proposed" or "Draft".

Communications via Internet e-mail regarding this application, other than those under 35


1 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be  
2 addressed to [daniel.felten@uspto.gov].

3 All Internet e-mail communications will be made of record in the application file. PTO  
4 employees do not engage in Internet communications where there exists a possibility that  
5 sensitive information could be identified or exchanged unless the record includes a properly  
6 signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly  
7 set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and  
8 Trademark on February 25, 1997 at 1 195 OG 89.

9  
10  
11 

12 DSF

13 July 8, 2003

  
HANI M. KAZIMI  
PRIMARY EXAMINER